

REMARKS

Claims 19-24 and 34-42 are pending in the present application. By virtue of this response, claim 23 has been canceled and claims 19, 20, 24, 41, and 42 have been amended. No new claims have been added. Therefore, after entry of the above amendments, claims 19-22, 24, and 34-42 will be under consideration.

Claim 19 has been amended to recite that the layered pharmaceutical carrier device has a water-erodable non-adhesive backing layer that comprises hydroxyethyl cellulose. Support for this amendment can be found at page 12, line 27 of the specification, among other places. In addition, claims 20, 24, 41, and 42 have been amended to ensure exact correspondence in the recited claim language, to correct claim dependency, or to correct certain typographical errors. Accordingly, no new matter has been added. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any claimed subject matter previously presented.

Status of “Withdrawn” Claims

Applicants respectfully request clarification regarding the status of the pending and withdrawn claims of the present application. Specifically, as Applicants previously noted in their prior Office Action response (dated April 25, 2003), claims 34, 36-39, 41, and 42 have not been withdrawn by the Applicants, yet they are indicated as “withdrawn” in the Office Action Summary. The notation of such withdrawal on the Office Action summary appears to be in error, since the prosecution history contains no evidence of any affirmative withdrawal of these claims.

Applicants have noted the Examiner’s statement that “withdrawn from consideration does not mean cancelled.” However, no restriction or election of species requirement has been directed toward these claims, necessitating their withdrawal. Indeed, only one restriction requirement has ever been given (paper No. 6), in response to which, Applicants elected (with traverse) the claims corresponding to group A--methods of “treating mucosal surfaces.” The

“withdrawn” claims fall within group A. Indeed, all pending claims depend from claim 19, which is directed towards methods of treating a treatment site of mucosal surfaces. Therefore, Applicants submit that their initial election should not have resulted in the withdrawal of claims 34, 36-39, 41, and 42.

In addition, as noted above, Applicants have not taken the affirmative step of withdrawing these claims on their own accord. Accordingly, if the Examiner wishes to maintain the status of these claims as “withdrawn,” then Applicants kindly request that the Examiner point to the particular paper withdrawing these claims from consideration, or in the alternative, provide other such reasoning for their withdrawal.

Rejection of Claims under 35 U.S.C. § 102(b)

Claims 19-24, 35, and 40 stand rejected under 35 U.S.C. §102(b) as being anticipated by WO 95/05416 (WO ‘416). Applicants respectfully submit that such rejection is moot in view of the above amendments. As noted above, claim 19 (from which the remaining rejected claims depend) has been amended to recite a second water-erodable non-adhesive backing layer comprising hydroxyethyl cellulose. WO ‘416 fails to teach or disclose a second water-erodable non-adhesive backing layer comprising hydroxyethyl cellulose, and therefore, fails to anticipate the claims.

Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. §102(b) be withdrawn.

CONCLUSION


Applicants have by way of the amendments and remarks presented herein, made a sincere effort to overcome the rejections and address all the issues raised in the Office Action.

Accordingly, reconsideration and allowance of the pending claims is respectfully requested. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 359872000810. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: December 8, 2003

By: 
Mika Mayer
Registration No. 47,777

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-4298
Facsimile: (650) 494-0792